

REMARKS

Claims 1 - 19 remain active in this application. The indication of allowability of claims 1 - 11 is noted with appreciation. Amendment of claims 12 and 18 has been requested to include substantially verbatim (e.g. modified only to provide proper syntax and antecedent language correspondence) recitations of allowed claim 1 presented in the previous response. Support for the amendments of the claims is found throughout the application, particularly in Figures 4 and 5 and the description thereof on pages 18 - 26 of the original specification as pointed out in the previous response in regard to claim 1. No new matter has been introduced into the application.

Claims 12 - 17 (sic: evidently 12 - 19) have been rejected under 35 U.S.C. §103 as being unpatentable over Kedar et al. in view of Hippenmeyer and Ikuzumi et al. (sic: Ikurumi et al.). This sole ground of rejection remaining at issue in this application is respectfully traversed for the reasons of record and the further remarks appended below.

Initially, it is respectfully pointed out that the Examiner seeks to summarize previously presented remarks and concludes that they are non-persuasive since claim 12 does not explicitly recite "focus" or "distance" and that, in regard to claim 18, articles of irregular size are inherent in the references applied. In this regard, it is respectfully pointed out that there is no requirement that the claims *explain* the invention or enumerate the meritorious effects of the invention but only to define the invention in a manner which is distinct from the prior art (e.g. by including some structure or step which *supports*, at least in part, a meritorious effect) and allows the scope of the claims to be reasonably determined (the latter requirement of the claims evidently being deemed to be

met by the Examiner). It is respectfully submitted that the function of a doubly telecentric lens arranged in combination with other elements or steps, such as a camera or imaging at constant magnification and resolution as recited in claims 12 and 18, respectively, as finally rejected does, in fact, support the meritorious effect of providing a well-focused image of a constant magnification regardless of distance from the objective lens of the doubly telecentric lens to the surface being imaged of articles which may be of different sizes resulting in different distances from the doubly telecentric lens objective. Therefore, it is respectfully submitted that there is no basis under 35 U.S.C. §103 for dismissing previously submitted arguments concerning substantive differences of the invention, as claimed, from the prior art applied based on omission of recitations of meritorious effects supported thereby or asserted inherency which has not been shown and/or logically demonstrated by the Examiner, especially where none of the prior art appears to consider differences in dimensions of articles imaged and where there is no significant change in distance from object to lens in either Kedar et al. (directed to imaging the interiors of multi-well plates) or Ikurumi et al. (directed to inspection of printed circuit boards of substantially constant thickness) and where focus is made substantially non-critical in Hippenmeyer by placement of an article to be imaged at a distance equal to the focal distance from the lens, focussed at infinity, and evidently exploiting focus near the hyperfocal distance and depth of field if the object is closer, as discussed at column 1, lines 55 - 62 of Hippenmeyer.

It is also respectfully submitted that the statement of the rejection in the present official action is, in large part, unclear, and from which it is

difficult to perceive the Examiner's position. It appears, in some passages, that text may have been omitted. For example, on page 4, the statement of the rejection refers to the application of Kedar et al. and Hippenmeyer to claim 2 which is now indicated to be allowable, the intended meaning of first several lines of the parenthetical passage of lines 6 - 10 is not discernible, text appears to be omitted from line 13 and a partial sentence fragment appears on lines 14 - 16. The sole sentence of the following paragraph asserting the conclusion of obviousness reads, in part:

"... at the time the invention was made to modify the camera system [of?] Kedar et al in view [?] fashion as disclosed by Ikurumi et al (sic) of Hippenmeyer as the same [?] so as to obtain a machine vision controlled system..."

Such a statement of the rejection clearly falls short of providing a *prima facie* demonstration of obviousness by a clear and convincing line of reasoning and it is respectfully submitted that a *prima facie* demonstration of the propriety of any rejection or objection must be made in order to oblige Applicant to provide a substantive response beyond pointing out the Examiner's failure to provide such a demonstration. There certainly is no obligation to speculate in regard to the Examiner's intended meaning in order to respond thereto.

In any event, while it is believed that the claims as finally rejected are clearly and patentably distinguished from the prior art applied, in order to satisfy the Examiner, amendment of claims 12 and 18 has been requested to include previous amendatory recitations of claim 1 (now allowed) therein. Therefore, it is respectfully submitted, since claims 12 and 18 are, upon entry of the requested amendments, a more comprehensive combination, including the entire

combination of allowed claim 1; in which more comprehensive combination unexpected meritorious effects are engendered (such as reduction of processing required to utilize information read from the surfaces of the objects, such as for sorting of the objects, since images of the information are produced at a constant size and magnification) and that claims 12 - 19 would be *prima facie* allowable over the applied prior art. For that reason, it is also respectfully submitted that entry of the requested amendments to claims 12 and 18 is well-justified and that no new issue can be raised since the requested amendatory language has previously been considered by the Examiner and allowed. Accordingly, entry of the above-requested amendments and reconsideration (regardless of whether or not the requested amendments are entered) and withdrawal of the sole ground of rejection are respectfully requested.

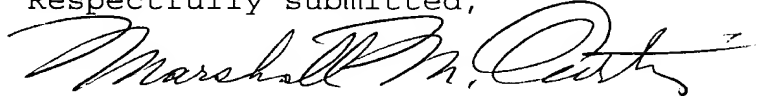
In this regard, it is also respectfully submitted that the finality of the present action is premature and should be withdrawn to allow the above-requested amendments to be entered as a matter of right since the present action (or the preceding action) does not make a *prima facie* demonstration of the propriety of the grounds of rejection contained therein. In any case, particularly since it is clear that no new issue can be raised by the requested amendments, entry at least for purposes of appeal should be permitted since issues would be materially reduced thereby.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that

this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Marshall M. Curtis", is written over the typed name.

Marshall M. Curtis
Reg. No. 33,138

Whitham, Curtis & Christofferson, P. C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190
(703) 787-9400

Customer Number: 30743